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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,023	02/02/2004	Nozomi Sawada	246853US-2 DIV	7240
22850	7590	02/29/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER KAU, STEVEN Y	
			ART UNIT 2625	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/768,023	Applicant(s) SAWADA, NOZOMI	
	Examiner Steven Kau	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9-15 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-15 and 18-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/2/04, 10/3/07, 12/5/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action acknowledges that the current application is a continuation application of and claims priority under 35 U.S.C. § 120, to U.S. application serial number 10/023,707, filed on December 21, 2001, which now is patented as U.S. 6,775,488.

Preliminary Amendment

This Office Action acknowledges the preliminary amendment filed on February 2, 2004.

- Claims 7, 8, 16 and 17 have been cancelled.
- Claims 1, 3-6, 9, 10, 12-15 and 18-20 have been amended.
- Claims 22 and 23 have been added; and
- Claims 1-6, 9-15 and 18-23 are currently pending.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-6, 9-15 and 18-23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 3, 4, 5, 6, 7, 8, 9 and 10 of US Patent NO. 6,775,488 in view of Kuwamoto et al (US 5,617,518). Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention scope of the claims is identical to the claims of US Patent NO. 6,775,488.

Re. claims 1-9 and 22 of current pending application, claims 2-9 dependent claims of Claim 1, and are drawn to an image forming apparatus, (claim 1) recites, "comprising: a memory configured to store setting information including at least a size of a substitute recording medium for each user; and a processor configured to execute a print instruction by automatically changing a size of a recording medium to be used to the size of the substitute recording medium based on the setting information stored in said storage means memory, when the size of the recording medium specified by the print instruction is not available" (emphasis added). Claim 22 has same claim limitations as claim 1, except that claim 22 has "means plus" function implemented.

Claims 1-4 of US Patent NO. 6,775,488 disclose similar claim limitations as claims 1-9 of the pending application.

Re. Claims 1-4 of US 6,775,488: claims 1, 2, 3 and 4 are independent image forming apparatus claims; claims 1 and 2 are implemented with "means plus" function in the claim language while claims 3 and 4 are not. Claim scope of claims 1-4 is identical: (a). storing setting information to include at least a size of a substitute recording medium; and (b). processing (by a configured processor) for executing a print instruction by automatically changing a size of a recording medium to be used to the size of the substitute recording medium based on the setting information stored in said storage (memory), when the size of the recording medium specified by the print instruction is not available. In addition, claims 1-4 each has a "wherein" clause for further different limitations.

Re. claims 1 & 22 in the current application vs claims 1-4 in US 6,775,488: claims 1 & 22 of the current pending application have the identical claim limitations as claims 1-4 of US 6,775,488 except for that Claim 1 of pending application has an element of "for each user" as highlighted in the above recitation and if the "wherein" clause is removed. The invention of current pending application is broader than US 6,775,488, which does not teach "for each user".

It has been known in the art of printing that a memory configured to store setting information for each user, for instance, Kuwamoto (US 5,617,518) discloses an output control method and system, comprising a word processors 201a-c of Fig 1 to store user's requirement such as paper size (setting information), etc. (user can register print

program, col 15, lines 17-20, and print command file 7000 of Fig. 24 designating user's ID for print job, col 17, lines 35-41).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified US 6,775,488 to include a memory configured to store setting information for each user taught by Kuwamoto to reduce user's burden at least for power saving and time (col 2, lines 35-46).

Re. claims 1-18 and 23 of the current pending application, are drawn to an image forming method with similar claim limitations of Claims 1 and 22 of the pending application, and as well as claims 5, 6 and 7 of US 6,775,488. Claims 1-18 and 23 of the pending application are rejected for the same reason discussed above in the rejection of claims 1-9 and 22.

Re. Claims 19 and 20-21 of the current pending application, are drawn to a computer-readable storage medium with similar claim limitations of Claim 1 and 22 of the pending application, and as well as claims 9 and 10 of US 6,775,488. Claims 19 and 20-21 of the pending application are rejected for the same reason discussed above in the rejection of claims 1-9 and 22.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 10, 19, 20, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuwamoto et al (Kuwamoto) (US 5,617,518).

Regarding claim 1.

Kuwamoto discloses an image forming apparatus (Print Server 202 of Figs. 1 & 2, col 8, lines 5-12) comprising: a memory (Hard Disc 26 and Main Memory 21 of Fig. 2) configured to store setting information (Print Programs 720, Print Program Files 700 of Fig. 6 and Print Program Management table 500 of Fig. 4, col 9, lines 17-44) including at least a size of a substitute recording medium (different paper size, col 20, lines 35-41) for each user (user can register print program, col 15, lines 17-20, and print command file 7000 of Fig. 24 designating user's ID for print job, col 17, lines 35-41); and a processor (CPU 10 and CPU 20 of Fig. 2) configured to execute a print instruction (print program) by automatically changing (switching by the page printing setting print command 7300) a size of a recording medium to be used to the size of the substitute recording medium (different paper size) based on the setting information stored in said memory (col print command 7300 is contained in print command file 7000 of Fig. 24, which stored in hard disc, col 16, lines 46-49), when the size of the recording medium specified by the print instruction is not available (col 16, lines 28-60 & col 20, lines 35-41).

Regarding claim 3.

Kuwamoto discloses wherein the memory is configured to store the setting information in response to an external setting instruction from outside (e.g. in response to word processor of 201a-c of Fig. 1, col 8, lines 5-67).

Regarding claim 4.

Kuwamoto discloses that a notifying device (CPU 20 of Fig. 2) configured to notify to the outside (201a-c of Fig 1) when the size of the recording medium specified by the print instruction is not available (e.g. paper finished, col 20, lines 35-41) or when corresponding setting information is not stored in the memory, together with information indicating an available size (different paper size) of the recording medium, so as to request the setting instruction (switching setting print command 7300) (Fig. 12, col 11, lines 56 through col 12, line 12 & col 20, lines 35-41).

Regarding claim 5.

Kuwamoto discloses a setting device configured (CPU 10 and 20 of Fig. 2) to set and store the setting information in the memory (col 8, lines 16-67).

Regarding claim 6.

Kuwamoto discloses wherein said setting information is stored in said memory storage means in the form of a table (Fig. 4, col 9, lines 17-25).

Regarding claim 9.

Kuwamoto discloses wherein said setting information is stored in said memory with respect to each user (e.g. print command file of Fig 24 designating user's ID for print job, col 17, lines 35-41).

Regarding claim 10.

Claim 10 recites identical features as claim 1, except claim 10 is an image forming method claim. Thus, arguments similar to that presented above for claim 1 are also equally applicable to claim 10.

Regarding claim 12.

Claim 12 recites identical features as claim 3, except claim 12 is an image forming method claim. Thus, arguments similar to that presented above for claim 3 are also equally applicable to claim 12.

Regarding claim 13.

Claim 13 recites identical features as claim 4, except claim 13 is an image forming method claim. Thus, arguments similar to that presented above for claim 4 are also equally applicable to claim 13.

Regarding claim 14.

Claim 14 recites identical features as claim 5, except claim 14 is an image forming method claim. Thus, arguments similar to that presented above for claim 5 are also equally applicable to claim 14.

Regarding claim 15.

Claim 15 recites identical features as claim 6, except claim 15 is an image forming method claim. Thus, arguments similar to that presented above for claim 6 are also equally applicable to claim 15.

Regarding claim 18.

Claim 18 recites identical features as claim 9, except claim 18 is an image forming method claim. Thus, arguments similar to that presented above for claim 9 are also equally applicable to claim 18.

Regarding claim 19.

Claim 19 recites identical features as claim 1, except claim 19 is a computer-readable storage medium claim. Thus, arguments similar to that presented above for claim 1 are also equally applicable to claim 19.

Regarding claim 20.

Claim 20 recites identical features as claim 1, except claim 20 is a computer-readable storage medium claim. Thus, arguments similar to that presented above for claim 1 are also equally applicable to claim 20.

Regarding claim 21.

Kuwamoto discloses wherein the computer program (e.g. print program 720 and print program file of Fig 6) is with respect to one of a computer within a host unit (e.g.. print server 202 of Fig. 1 and Fig. 2) which outputs the print instruction with respect to an image forming apparatus (col 15, lines 61 through col 16, line 9 for one embodiment) and a computer within the image forming apparatus which prints the information on the recording medium (col 18, line 59 through col 19, line 58).

Regarding claim 22.

Claim 22 recites identical features as claim 1. Thus, arguments similar to that presented above for claim 1 are also equally applicable to claim 22.

Regarding claim 23.

Claim 23 recites identical features as claim 1, except claim 23 is an image forming method claim. Thus, arguments similar to that presented above for claim 1 are also equally applicable to claim 23.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 & 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwamoto et al (Kuwamoto) (US 5,617,518) as applied to claim 1 above, and in view of Cloutier et al (Cloutier) (US 6,018,397).

Regarding claim 2.

Kuwamoto differs from claim 2, in that he does not expressly disclose wherein said setting information includes whether or not a zoom is required when printing information, and/or a printing position on the recording medium.

Cloutier teaches wherein said setting information includes whether or not a zoom is required when printing information, and/or a printing position on the recording medium (print aspect ratio, size and zoom, col 3, lines 2-12).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kuwamoto to include setting information includes whether or not a zoom is required when printing information, and/or a printing position on the recording medium taught by Cloutier to allow user to select desired image

parameter settings to produce hardcopies with satisfactory image quality (col 1, lines 60-64).

Regarding claim 11.


Claim 11 recites identical features as claim 2, except claim 11 is an image forming method claim. Thus, arguments similar to that presented above for claim 2 are also equally applicable to claim 11.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Kau whose telephone number is 571-270-1120 and fax number is 571-270-2120. The examiner can normally be reached on M-F, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on 571-272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Kau
Patent Examiner
Division: 2625
February 15, 2008



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